

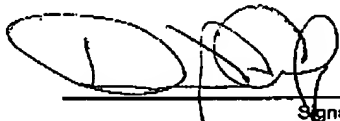
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		67,108-043; Wong 1	
CERTIFICATE OF FACSIMILE I hereby certify that this Pre-Appeal Brief Request For Review and Notice of Appeal are being facsimile transmitted to (571) 273-8300. on <u>November 14, 2005</u> Signature _____ Typed or printed name <u>Theresa M. Palmateer</u>		Application Number <u>09/827,226</u>	Filed <u>04-05-2001</u>
		First Named Inventor <u>Marcus Wong</u>	
		Art Unit <u>2136</u>	Examiner <u>Shiferaw, Eleni A.</u>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		David J. Gaskey	
		Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>37,139</u>		<u>248-988-8360</u>	
		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>November 14, 2005</u>	
		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Serial No. 09/827,226
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Marcus Wong

Serial No.: 09/827,226

Examiner: Shiferaw, Eleni A.

Filed: April 5, 2001

Group Art Unit: 2136

Title: SYSTEM AND METHOD FOR PROVIDING SECURE
COMMUNICATIONS
BETWEEN WIRELESS UNITS USING A COMMON KEY

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant is filing a Notice of Appeal concurrently with this request.

Applicant respectfully traverses the rejections under 35 U.S.C. §103 based upon the proposed combination of *Johnston*, *Terao*, *et al.*, and *Ellison*. There is no *prima facie* case of obviousness.

A proposed combination cannot be made where it goes directly contrary to the teachings of the primary reference. A proposed modification to the primary reference cannot defeat an intended operation or remove an intended feature of the teachings of that reference. In this instance, the Examiner's proposed combination undoes one of the stated goals of the *Johnston* reference. The Examiner proposes adding a "common key" from *Terao*, *et al.* into the *Johnston* arrangement. This is directly contrary to the intention of *Johnston*'s teachings.

At column 3, lines 36-42, *Johnston* teaches that it wants to avoid having more than one of the mobile terminals knowing the key of the other terminal(s). In particular, *Johnston* states, "Thus in accordance with the invention, each terminal is provided with a partial key

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from the remote location that includes masked data concerning the terminal key of the terminal itself, without the need for the key of the other terminal." *Johnston*, therefore, wants to avoid a common key. Instead, *Johnston* relies upon using different keys at each of the terminals to maintain security of the keys.

Therefore, there is no motivation for making the substitution proposed by the Examiner. It goes directly contrary to the intentions of the *Johnston* reference and the combination cannot be made.

Another reason why there is no motivation to combine is that *Terao, et al.* use a common key for co-owned, similarly located devices. That is not the type of arrangement contemplated in *Johnston*. One dealing with a system like *Johnston* would not look to the teachings of *Terao, et al.* because they are used in different contexts. Applicant's disclosure cannot be used as a basis for a word search to extract a term from a reference to plug into another. The teachings of the references must be considered. The combination cannot be made.

The proposed addition of the teachings of *Ellison* does not remedy the defect preventing the combination of *Johnston* and *Terao, et al.* Further, *Ellison* is concerned with secure communication between a computer and another hardware device, neither of which appears to be a wireless communication device.

There is no motivation for making the proposed combination and no *prima facie* case of obviousness. None of the claims can be considered obvious on that basis.

Further, even if the combination could somehow be made, the result is not the same as what is claimed in many of Applicant's claims. If one were to substitute in the common key from *Terao, et al.* into the *Johnston* arrangement, the result would not be the same as any of claims 2-20. *Terao, et al.* pre-store the common key in devices that are sold together as a

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single set to a single user. Paragraph 138, lines 1 and 2, and paragraph 140, lines 1-6 in *Terao, et al.* indicate this. Therefore, even if one substituted in the pre-stored common key of *Terao, et al.* into the *Johnston* arrangement (which cannot be done as discussed above), that would not be the same as performing at least one of the steps from each of claims 2-20 so that there is no *prima facie* case of obviousness against those claims.

One cannot modify the teachings of *Terao, et al.* using the teachings of *Ellison* in an attempt to somehow render the combination the same as Applicant's claims. Doing so would be contrary to the teachings of the *Terao, et al.* reference and there is no motivation for making such a substitution. Further, such a layered modification of references could only be the result of hindsight reasoning based upon Applicant's own disclosure and claims. There is nothing within the references that suggests the combination proposed by the Examiner. Even if the combination could somehow be made, the result is not the same as Applicant's claims.

The rejection of record must be withdrawn.

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.

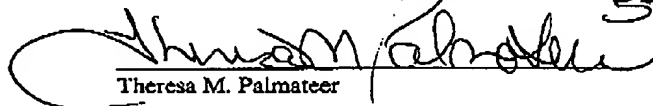
By: 

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Dated: November 14, 2005

CERTIFICATE OF FACSIMILE

I hereby certify that this Request for Pre-Appeal Brief Conference, relative to Application No. 09/827,226 is being facsimile transmitted to the United States Patent and Trademark Office, (703) 872-9306, on November 14, 2005.


Theresa M. Palmateer

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